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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/833,347

04/12/2001

Rabindranath Dutta

AUS920010214US1

3791

35525 7590 12/18/2006
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EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/18/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	09/833,347		DUTTA ET AL.	
	Examiner		Art Unit	
	Dan Kesack		3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 16, 17, 19-30, 34-45, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) 9-12, 17, 27-30 and 42-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 19-26, 34-41, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/15/06; 9/25/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment filed September 28, 2006 has been entered and fully considered. Claims 1-12, 16, 17, 19-30, 34-45, 49, and 50 are currently pending. The rejections are as stated below.

Election/Restrictions

2. As a result of Applicant's amendment, filed 9/28/06, Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, 16, 19-26, 34-41, 49, 50 drawn to a system and method for scanning a check and performing a transaction at an ATM.
 - II. Claims 9-12, 17, 27-30, 42-45, drawn to a system and method for generating a new check at an ATM.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination of group II has separate utility

such as generating a new check for payment, and the user obtaining an image of the new check. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Wayne Bailey on December 1, 2006 a provisional election was made without traverse to prosecute the invention of group I, claims 1-8, 16, 19-26, 34-41, 49, 50. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-12, 17, 27-30, 42-45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 5-8, 19, 23-26, 34, 38-41, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde, Jr., U.S. Patent No. 6,038,553, in view of Uhland, Sr., U.S. Patent No. 5,444,794, and further in view of Joao et al., U.S. Patent Application Publication No. 2001/0051920.

Claims 1, 8, 19, 26, 34, 41, Hyde teaches a system and method of cashing checks without human intervention, comprising receiving a check from a user at an automatic teller machine (column 4 lines 52-57), scanning the check to generate an image (column 5 lines 3-6) and transmitting the image to a financial institution data processing system (column 5 lines 3-6), and performing a transaction involving the check at the financial institution data processing system to generate a transaction result (column 5 lines 15-23), and transmitting the transaction result to the automatic teller machine (column 6 lines 27-32).

Claims 1, 19, 34, Hyde fails to teach transmitting the image and the transaction result to a mobile device associated with the user.

Uhland teaches transmitting a check image and a transaction result to a user (column 5 lines 6-21). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hyde to include transmitting the check image and a transaction result to a user because it is desirable that the user receive notification of transactions for the purposes of security and for personal record keeping.

Claims 1, 5, 6, 8, 19, 23, 24, 26, 34, 38, 39, 41, the combination of Hyde and Uhland fails to teach transmitting to a mobile device associated with the user.

Joao discloses a financial transaction and wireless communication device and method, wherein a user receives transaction notification data, which identifies a transaction, via a mobile device (abstract and paragraph 49). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hyde and Uhland to include transmitting the information to a mobile device because of the security and convenience provided by mobile devices as described by Joao (paragraphs 7-9).

Claim 7, 35, 40, Hyde teaches capturing an image of a user at an automatic teller machine (column 7 lines 39-54).

8. Claims 2, 4, 20, 22, 35, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde, Jr., in view of Uhland, Sr. and Joao, as applied above, and

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further in view of Jones et al., U.S. Patent No. 6,661,910. Hyde, Uhland, and Joao fail to teach importing the image and the transaction result into a financial program usable to manage finances, a such that the current account balance and the image of the check are accessible.

Jones discloses a network for transporting and processing images in real time, wherein home banking software allows customers to receive account balances, and obtain images of deposited documents. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hyde, Uhland, and Joao to include importing the transaction results and check images into home banking software because it is desirable that a bank customer have access to these items for security purposes, and for a customer to keep track of personal finances.

9. Claims 3, 21, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde, Jr., in view of Uhland, Sr., Joao, and Jones, as applied above, and further in view of the Souccar article "Visa in Partnership to Develop Wireless Financial Applications."

Hyde, Uhland, and Joao fail to teach a financial program being on a mobile device.

Souccar teaches financial applications for mobile devices. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hyde, Uhland, Joao, and Jones to include financial programs on

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mobile devices because of the advantages provided by mobile devices, as described by Joao (paragraphs 7-9).

Claims 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde, Jr., in view of Uhland, Sr., Joao, as applied to claims 1 and 19 above, and further in view of Ansley, U.S. Patent Application Publication No. 2002/0133437.

Hyde, Uhland, and Joao fail to teach transmitting the image and financial transaction information from the mobile device to another data processing system.

Ansley discloses a financial management system and method wherein transaction data is sent from a mobile device to a base station database for the purpose of synchronizing all data (figure 6 steps 615-625). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hyde, Uhland, and Joao to include synchronizing the financial data with a base station database because the mobile device receives new transaction updates, and it is required that the base station database contain the most current information pertaining to a user's account.

Response to Arguments

10. Applicant's arguments with respect to claims 1-8, 19-26, and 34-41 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

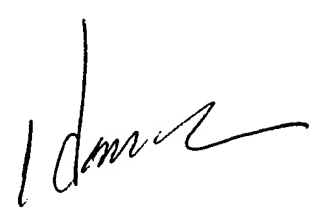
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HANI M. KAZIMI
PRIMARY EXAMINER